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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/676,042	10/02/2003	Mark H. Shipton	117313	6932

25944 7590 08/16/2005

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EXAMINER

KOEHLER, ROBERT R

ART UNIT PAPER NUMBER

1775

DATE MAILED: 08/16/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

**Application No.**

10/676,042

**Applicant(s)**

SHIPTON ET AL.

**Examiner**

Robert R. Koehler

**Art Unit**

1775

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on July 14, 2005 (Amdt.).
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-14 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☒ Claim(s) 1-7 is/are allowed.
- 6) ☒ Claim(s) 8-14 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some \* c) ☐ None of:
- 1) ☒ Certified copies of the priority documents have been received.
  - 2) ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - 3) ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

RRK  
8-11-05

### Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_

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## DETAILED ACTION

### *Claim Rejections - 35 USC § 102/§ 103(a)*

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 8 to 14 are rejected under 35 U.S.C. 102(b) as anticipated by or, in the alternative, under 35 U.S.C. 103(a) as obvious over PCT International Application No. WO 94/18359 (WO '359).

PCT International Application No. WO '359 discloses thermal methods of forming a stable intermetallic diffusion barrier on metallic substrates such as titanium alloys. The diffusion barrier comprises platinum and aluminum. The platinum aluminide diffusion barrier is formed by depositing a first layer of platinum metal on the substrate, depositing a second layer of aluminum metal on the first layer, and performing a reaction treatment which causes the platinum and aluminum metals to combine and form the platinum aluminide layer. The process disclosed by WO '359 would be expected to produce the same platinum aluminide diffusion barrier layer on a titanium alloy substrate as claimed by the applicants. See line 30 on page 2 to line 12 on page 6.

In the event any differences can be shown for the product of the product-by-process claim(s) 8 to 14, as opposed to the product taught by the cited reference WO '359, such

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differences would have been obvious to one of ordinary skill in the art as a routine modification of the product in the absence of a showing of unexpected results. See also *In re Thorpe*, 227 USPQ 964. Any difference imparted by the product-by-process limitations would have been obvious to one having ordinary skill in the art at the time the invention was made because where the Examiner has found a substantially similar product as in the applied prior art, the burden of proof is shifted to the applicant to establish that the claimed product is patentably distinct from the prior art product. See *In re Brown*, 173 USPQ 685 and *In re Fessmann*, 180 USPQ 324.

### ***Allowable Subject Matter***

Claims 1 to 7 are allowed.

The following is a statement of reasons for the indication of allowable subject matter:

The prior art does not teach, suggest, or disclose applicants' amended claims to a method of forming a platinum aluminide diffusion barrier on a titanium alloy substrate including the step of applying to a titanium alloy substrate a coating comprising particulate platinum and particulate aluminum in an organic carrier.

### ***Response to Arguments***

Applicant's arguments with respect to claims 8 to 14 have been considered but are moot in view of the new ground(s) of rejection. The Examiner has reconsidered the subject matter contained in International Application No. WO 94/18359, and believes that product-by-process claims 8 to 14 should be rejected because WO '359 discloses the same platinum aluminide diffusion barrier on a titanium alloy substrate as claimed by the applicants. Also, the Examiner respectfully suggests that line 4 of claim 1 (Currently Amended) be amended to delete the word "metallic" because amended claim 1 refers to a "titanium alloy" substrate.

### ***Conclusion***

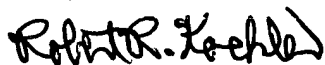
Any inquiry concerning this communication or earlier communications from the Examiner should be directed to Robert Koehler whose telephone number is (571) 272-1536.

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The Examiner can normally be reached on Tuesday to Friday from 9:30 AM to 7:00 PM. The Examiner can also be reached on alternate Mondays.

If attempts to reach the Examiner by telephone are unsuccessful, the Examiner's supervisor, Deborah Jones, can be reached on **(571) 272-1535**. The fax phone number for the organization where this application or proceeding is assigned is **703-872-9306**.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at **866-217-9197** (toll-free).



**ROBERT R. KOEHLER**  
**PRIMARY EXAMINER**

**Art Unit 1775**  
**August 11, 2005**